



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,191	11/28/2000	Satoshi Machino	70868-55282	7748
21874	7590	12/08/2004	EXAMINER	
EDWARDS & ANGELL, LLP			DALENCOURT, YVES	
P.O. BOX 55874			ART UNIT	PAPER NUMBER
BOSTON, MA 02205			2157	

DATE MAILED: 12/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/724,191	MACHINO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Yves Dalencourt	2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 07 September 2004.

2a) This action is **FINAL**.                                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 21-34 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 21-34 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 06/04/01.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

This office action is responsive to amendment filed on 09/07/2004.

### ***Response to Amendment***

The examiner has acknowledged the cancellation of claims 1 – 20, and the submission of new claims 21 – 34.

### ***Response to Arguments***

Applicant's arguments with respect to claims 21 - 34 have been considered but are moot in view of the new ground(s) of rejection.

### ***Specification***

The amendment filed on 07/26/2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: In another embodiment, a server processes electronic mail communication with clients over a distributed computing network. The server includes a memory .....the electronic mail message to the list of recipients (page 5, second paragraph).

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Objections***

Claim 1 is objected to because of the following informalities: It is suggested to delete " an " (claim 21, line 1). Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 24 – 29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 24, the limitations of "a memory storing an instruction set, templates, rules for settings, group names associated with a plurality of registrants, and mail addresses related ..... and transmit the electronic mail message to the list of recipients (claim 24) " were not described in the original specification. Such limitations were not originally disclosed. Therefore, one skilled in the art would not know how to make and/or use the invention.

Claims 25 – 29 are necessarily rejected as being dependent upon the rejection of claim 24.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 27 recites the limitation "the user" in line 2. There is insufficient antecedent basis for this limitation in the claim. A – user – has not previously been identified.

Claim 28 is necessarily rejected as being dependent upon the rejection of claim 27.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21 – 23 and 30 - 34 are rejected under 35 U.S.C. 102(b) as being anticipated by lida Hiroshi (JP-A 5-219103; hereinafter lida).

Regarding claims 21, 23, and 30, lida teaches a method and apparatus for composing electronic mail message (fig. 1) comprising the steps of composing a body of a message (para.0013; lida discloses that a user can input a message or can set up various kinds of conditions, which reads on the claim limitation since applicant fails to mention that such step is being done without user's intervention); selecting registrant data for a prescribed area (para. 0014; lida discloses that if a group's destination is described here, email will be transmitted to the each people destination belonging to the group); selecting attributes and a setting for association with the body of the message,

the attributes and the setting for determining a list of recipients of the message according to the registrant data in the prescribed area (paras. 0015 and 0019; lida discloses that when the group destination is described by destination information , once developing the group destination described by the individually-addressed point group, this individually-addressed point is replaced with the group destination described by the destination information in an e-mail sheet, and mail for the number which should transmit is create); and sending the message to the list of recipients (para. 0016; para 0019, lines 11 – 12; and para. 0020; lida discloses that mail for the number which should transmit original mail had been created by this. The usual transmitting processing is performed at the step after this).

Regarding claim 22, lida teaches a method for composing electronic mail message (fig. 1), wherein the attributes are a group name, file name and template (paras. 009 - 0014).

Regarding claims 31 - 34, lida teaches a method for composing electronic mail message (fig. 1), wherein the first, second and third means is a desktop computer, and wherein the first means is a computer in communication with a distributed computing network (paras. 0009 - 0011).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

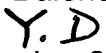
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

#### **Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yves Dalencourt whose telephone number is (571) 272-3998. The examiner can normally be reached on M-TH 7:30AM - 6: 00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Yves Dalencourt  
  
November 29, 2004



MARIO ETIENNE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100